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EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JESSE J. WILLIAMS,
ERIC J. HANSEN, and
LINDSAY M. ULMAN

Appeal 2009-005995
Application 10/604,780
Technology Center 1700

Before MICHAEL P. COLAIANNI, CHUNG K. PAK, and
JEFFREY T. SMITH, *Administrative Patent Judges.*

COLAIANNI, *Administrative Patent Judge.*

DECISION ON APPEAL[1]

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 49, 51, 52, 54 through 59, 94 through

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

99, and 115. Claims 1 through 48, 87 through 93, and 100 through 113, the other claims pending in this application, stand withdrawn from consideration by the Examiner. We have jurisdiction under 35 U.S.C. § 6.

We REVERSE.

The subject matter on appeal is directed to a manual spray cleaner. The Examiner maintains the following rejections:

1) Claims 49, 51, 52, 54, 96-98, and 115 under 35 U.S.C. § 103(a) as unpatentable over Seglin (US 3,488,287; issued Jan. 6, 1970);

2) Claims 55 and 56 under 35 U.S.C. § 103(a) as unpatentable over Seglin and Hart (US 3,970,584; issued July 20, 1976);

3) Claim 57 under 35 U.S.C. § 103(a) as unpatentable over Seglin and Miles (US 3,722,753; issued Mar. 27, 1973);

4) Claims 58 and 59 under 35 U.S.C. § 103(a) as unpatentable over Seglin, Miles, and Barger '492 (US 5,421,492; issued Jun. 6, 1995);

5) Claim 94 under 35 U.S.C. § 103(a) as unpatentable over Seglin, Hart, and Barger '447 (US 5,921,447; issued Jul. 13, 1999);

6) Claim 95 under 35 U.S.C. § 103(a) as unpatentable over Seglin and Spitzer (US 3,970,219; issued Jul. 20, 1976); and

7) Claim 99 under 35 U.S.C. § 103(a) as unpatentable over Seglin and Lauwers (US 6,021,926, issued Feb. 8, 2000).

REJECTION (1)

ISSUE

Did the Examiner err by failing to weigh all the evidence of non-obviousness, including evidence showing the level of ordinary skill in the art, against the facts on which the Examiner's prima facie case of

obviousness is based in determining obviousness? We decide this issue in the affirmative.

PRINCIPLES OF LAW

It is well settled that evidence which do not qualify as prior art because it post-dates the claimed invention may be relied upon to show the level of ordinary skill in the art at the time of the invention. *See Ex parte Erlich*, 22 USPQ2d 1463, 1466 (BPAI 1992) *citing Thomas & Betts Corp. v. Litton Systems, Inc.*, 720 F.2d 1572, 1581 (Fed. Cir. 1983) ("[references] though not technically prior art, were, in effect, properly used as indicators of the level of the ordinary skill in the art to which the invention pertained").

"When prima facie obviousness is established and evidence is submitted in rebuttal, the decision-maker must start over." *In re Rinehart*, 531 F.2d 1048, 1052 (CCPA 1976). The totality of the evidence must be weighed to determine whether the claimed invention by a preponderance of the evidence would have been obvious. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). "[T]he term '*prima facie* obvious' relates to the burden on the Examiner at the initial stage of the examination, while the conclusion of obviousness *vel non* is based on the preponderance of evidence and argument in the record." *Oetiker*, 977 F.2d at 1447.

FACTUAL FINDINGS, ANALYSIS, AND CONCLUSION

Appellants rely on the Tait publication as evidence of non-obviousness to show the level of ordinary skill in the art. Specifically, Appellants allege that the Tait publication shows that one of ordinary skill in the art believed that an aerosol composition cannot be stored in an unlined aluminum container such that (1) one of ordinary skill in the art would not

have interpreted Seglin as teaching or suggesting that an aerosol composition can be stored in an unlined aluminum container; and 2) the stability of aerosol compositions in uncoated aluminum containers is an unexpected result. (App. Br. 7-9 and 12 and Reply Br. 2).

The Examiner must weigh this evidence against the facts on which the Examiner's prima facie case of obviousness is based to determine whether the claimed invention would have been obvious. *See Oetiker*, 977 F.2d at 1445.

The Examiner, however, has not done so. In this regard, the Examiner states that the Tait publication was not considered because it "[is] not a prior art reference due to its March 2006 publication date," which is more than two years after Appellants' filing date (i.e., Aug. 15, 2003). (Ans. 11-12; *see also* Ans. 13).

Contrary to the Examiner's statement, however, it is well settled that evidence which does not qualify as prior art because it postdates the claimed invention may be relied upon to show the level of ordinary skill in the art at or around the time of the invention. *See Erlich*, 22 USPQ2d at 1466.

In this regard, in reference to our above discussion, Appellants rely on the Tait publication to show that "at least as late as . . . 2006," which includes Appellants' filing date of Aug. 15, 2003, one of ordinary skill in the art believed that an aerosol composition cannot be stored in an unlined aluminum container. Thus, because Appellants rely on the Tait publication as evidence to show the level of ordinary skill in the art at or around the time of the invention, it is not necessary that the Tait publication qualify as available prior art.

Accordingly, the Examiner should have weighed this evidence against the facts on which the Examiner's prima facie case of obviousness is based to determine whether the claimed invention would have been obvious. Since the Examiner has not done so, it follows that the Examiner erred by failing to weigh all the evidence of non-obviousness, including evidence showing the level of ordinary skill in the art, against the facts on which the Examiner's prima facie case of obviousness is based in determining obviousness.

Accordingly, we reverse the Examiner's decision rejecting claims 49, 51, 52, 54, 96-98, and 115 under § 103 over Seglin.

REJECTIONS (2) THROUGH (7)

The Examiner relies on the same factual findings and determinations discussed above and does not provide any additional findings or reasoning regarding the evaluation of Appellants' evidence of non-obviousness. Therefore, for the reasons stated above, we reverse the Examiner's decision to reject the claims stated in rejections (2) through (7).

DECISION

The Examiner's rejections (1) through (7) are reversed.

REVERSED

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